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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,405

04/14/2004

Elaine Jacobson

NIAD 216.2 DIV

9384

24972 7590 02/12/2010
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EXAMINER

RICCI, CRAIG D

ART UNIT

PAPER NUMBER

1628

MAIL DATE

DELIVERY MODE

02/12/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/825,405	Applicant(s) JACCOBSON ET AL.	
	Examiner CRAIG RICCI	Art Unit 1628	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 13, 15 and 18-24.
 Claim(s) withdrawn from consideration: 14, 16-17.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/CRAIG RICCI/
 Examiner, Art Unit 1628

/Brandon J Fetterolf/
 Primary Examiner, Art Unit 1642

Continuation of 3. NOTE: Instant claim 1 has been amended to include the limitation wherein the human subject is in need of increased leptin levels. As such, the proposed amendment raises issues that have not been previously considered and would require additional search and consideration. For this reason, the claims have not been entered..

Continuation of 11. does NOT place the application in condition for allowance because: As discussed above, the proposed claims would raise additional issues that would require further consideration and search. Accordingly, the claims have not been entered. Applicants' arguments to such claims are thus rendered moot. Applicants additionally argue that it would not have been predictable to substitute one known nicotinic alkyl ester taught to be useful for the treatment of sunburn with another nicotinic alkyl ester taught to be useful for the treatment of sunburn to formulate a composition to be used for the treatment of sunburn. However, Applicants' argument is not considered persuasive. Applicants are reminded that obviousness does not require absolute predictability, only a reasonable expectation of success of obtaining similar results. In the instant case, it would have been reasonable to expect the prima facie obvious composition to be useful for the treatment of sunburn (i.e., a human subject in need of improved skin epitheliation). Applicants again argue that Scivoletto teaches the use of methyl ester (which would cause vasodilation). Yet, Applicant is again reminded that one can not show nonobviousness by attacking references individually where the rejections are based on combinations of references. In the instant case, Jacobson et al specifically disclose administration of longer chain nicotinic alkyl esters which do not result in vasodilation. Applicant additionally indicates that the "non final rejection included a rejection of claims 13, 15 and 18-21 at page 3... there is no rejection of claims 19-21" (Applicant Argument, Page 6). However, the claims 19-21 were rejected on Page 3 since they are part of the claims 18-21 that were rejected on Page 3.